



TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

QINETIQ LIMITED

Petitioner,

v.

KINETIC MARKETING
INC.

Registrant.

Cancellation No. 92045288

**APPLICANT'S REPLY TO OPPOSER'S OPPOSITION TO APPLICANT'S MOTION
TO CONSOLIDATE; AND APPLICANT'S OPPOSITION TO REGISTRANT'S
MOTION TO SUSPEND ALL PROCEEDINGS PENDING DISPOSITION OF
PETITIONER'S MOTION TO CONSOLIDATE**

A. Reply to Motion to Consolidate

Notwithstanding Registrant's assertions, the three proceedings involved in this motion to consolidate (Cancellation No. 92045288 regarding computers and computer programs, Cancellation No. 92045572 regarding cameras and Opposition No. 91168895 regarding cameras) concern closely related issues of fact and law - - *i.e.*, the parties are the same; the same two marks are involved; the various channels of trade are the same; and, in two proceedings, the goods are both camera products, whereas in the third proceeding the goods are computer products.

Specifically, the nature of both Kinetic Marketing and QinetiQ's goods and services, their various channels of trade and prospective customers are critical to all three proceedings. Both of the Petitions for Partial Cancellation deal with a likelihood of confusion between the mark KINETIC versus QINETIC in addition to issues of abandonment/ nonuse and validity of the



involved registrations. The Opposition also deals with a likelihood of confusion between the mark KINETIC versus QINETIC, in addition to concerning the priority of use of certain types of camera goods. Notably, Cancellation No. 92045572 could have been raised as a counterclaim in Opposition No. 91168895.

In short, the marks in all three proceedings are the same (KINETIC vs. QINETIQ). The parties are the same. Furthermore, cameras are involved in two proceedings and computer products are involved in one proceeding. Thus, although Opposer tries to ignore these simple facts, they establish the need to consolidate the three cases.

Indeed, it is likely that there would be significant overlap in any testimony regarding the nature of the parties' businesses, the goods and services of each of the parties, their channels of trade, their mediums of advertising and their target markets. Accordingly, since the actions clearly involve common questions of fact and law, and it is probable that time, effort and expense will be saved by doing so, it makes sense to consolidate the proceedings.

The Opposer argued that consolidation before the answer to the Petition to Cancel in Cancellation No. 92045572 is filed is premature. However, it is within the Board's discretion to consolidate. *See* TBMP Section 511 ("[T]he Board may, in its discretion, order cases consolidated prior to joinder of issue.")

Opposer does not indicate how it will be unduly prejudiced by grant of this motion without specific restrictions on the consolidation. In fact, Opposer's clear intent is to delay these proceedings and to increase the litigation costs to extort settlement money from QinetiQ. This is a pattern of activity that Opposer has engaged in before at the TTAB. *See* Exhibit 1, Kinetic

Marketing Inc. v. Sony Computer Entertainment America, Inc., (Opposition No. 91162895).¹

At the very least, Cancellation No. 92045572 regarding cameras and Opposition No. 91168895 regarding cameras should be consolidated as both action involve the same parties, the marks KINETIC vs. QINETIQ, camera goods and channels of trade. It is Applicant's position that Cancellation No. 92045288 should also be combined with the other two proceedings since the parties, marks and channels of trade are the same.

B. Opposition to Motion to Suspend All Proceedings

Kinetic has provided no indication of how consolidation of the Cancellations and Opposition at issue in this motion will impact negatively either party's preparation of its pre-trial and trial strategy. In short, it has failed to justify the need for suspension of the proceedings, including staying the dates for the parties to respond to the outstanding discovery.

Consolidation of the cases will only delay Kinetic's response to discovery in these cases, which is clearly Kinetic's intention. QinetiQ is entitled to Kinetic Marketing's cooperation in the production of discovery in order to support the two cancellations it brought and to enable it to effectively defend itself in the opposition raised by Kinetic. Kinetic has shown a proclivity to try to delay its discovery obligations as evidenced by the unsuccessful motion it brought in Opposition No. 91162895 against Sony Computer Entertainment America, Inc. *See* Exhibit 1. QinetiQ has already provided substantive responses to Kinetic Marketing's outstanding discovery requests in Opposition No. 91168895. *See also* Exhibit 2, a letter from Kinetic

¹ In that Opposition, in an unconsented motion, Kinetic Marketing asked the Board for a second extension of time to extend its testimony period. Sony, in that case, had already granted Registrant a 60 day extension of its testimony period, and then another fourteen days. In Sony's Opposition to Registrant's motion, Sony asserted that Kinetic was requesting the motion in bad faith because Kinetic had had sufficient time for their testimony period and appeared to be requesting the time in bad faith to file additional opposition papers. After considering the parties briefing, the Board agreed with Sony and found that Kinetic had not provided sufficient good cause for its extension request.

Marketing, which indicates they are refusing to respond to QinetiQ's outstanding discovery requests. It would unfairly prejudice QinetiQ to stay the dates for Kinetic to respond to QinetiQ's discovery.

C. Conclusion

In summary, QinetiQ requests that the Board consolidate the proceedings because they share common issues of fact and law and deny in total Kinetic's motion to suspend the proceedings.

Respectfully submitted,


QINETIQ LIMITED

By: 

Sheryl Scharmach
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing "APPLICANT'S
REPLY TO OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO
CONSOLIDATE; AND APPLICANT'S OPPOSITION TO REGISTRANT'S MOTION
TO SUSPEND ALL PROCEEDINGS PENDING DISPOSITION OF PETITIONER'S
MOTION TO CONSOLIDATE" was served on counsel for Opposer, Julie B. Seyler,
Abelman, Frayne & Schwab, 666 Third Avenue, New York, New York 10017, via First
Class Mail this 31st day of March, 2006.


Sheryl Scharmach

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Mailed: February 22, 2006

Opposition No. **91162895**

KINETIC MARKETING INC.

v.

Sony Computer Entertainment
America Inc.

Linda Skoro, Interlocutory Attorney

This case now comes up on opposer's motion to extend discovery and testimony periods, filed October 27, 2005. Applicant has opposed the request.

As grounds for the request for an extension of time, opposer states that it is a small business and the president travels extensively and has not been able to prepare his testimony and additional time is sought to discuss settlement. Applicant argues that it has previously granted a 60-day extension to complete discovery in the hopes of reaching settlement, but opposer did not contact applicant

during that extension period and not until 3 days before its testimony period was set to close. Applicant also states that it proposed settlement and believes that this motion was made in bad faith.

The standard for allowing an extension of a prescribed period prior to the expiration of that period is good cause. Fed. R. Civ. P. 6(b)(1). In this case, opposer alleges that it needs an additional forty-five days to prepare its testimony. We find that opposer has not established sufficient good cause to warrant an extension of the testimony period, and therefore the motion is denied. Opposer instituted this proceeding and has the responsibility to prosecute it diligently. A busy travel schedule does not constitute good cause for an extension of the time periods, particularly in light of the fact that opposer did not avail itself of the extension it had already been granted by applicant.

While the Board will not reopen the discovery period, it will reset the remaining dates in light of the delay occasioned in deciding the motion. The dates are reset as indicated below:

Discovery period to close:	CLOSED
30-day testimony period for party in position of plaintiff to close:	3/30/2006
30-day testimony period for party in position of defendant to close:	5/29/2006

15-day rebuttal testimony period to close:

7/13/2006

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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March 27, 2006

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Re: KINETIC MARKETING INC.
Trademark KINETIC and Opposition
By QinetiQ Limited
Trademark QINETIQ (Appln. No. 76/228427)
In the United States.
Opposition No. 91168895
(Your Ref.: 124-1147; Our Ref.: 213427)

Dear Ms. Scharmach:

I refer to my letter dated March 23.

I note that Qinetiq served a First Set of Interrogatories and Document Requests on Kinetic in connection with Opposition No. 91168895 on February 27, 2006.

In our letter dated March 23, we articulated our good faith reasons as to why we were not in a position to respond to any Discovery while the Motions to Amend and Consolidate are pending. It may not have been clear that these reasons would also apply to the written Discovery served on February 27, 2006.

I am also clarifying that based on our prior analysis, we will not be responding to Applicant's First Set of Requests for Admissions to Opposer and Applicant's Second Request for Production of Documents and Things served on March 21, 2006.

ABELMAN, FRAYNE & SCHWAB

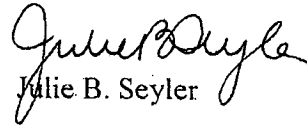
Sherri Scharmach, Esq.

March 27, 2006

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We shall be filing an Answer to the Amended Petition to Cancel as well as an Answer to the Petition for Partial Cancellation.

Sincerely,


Julie B. Seyler

JBS:rd